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PATENT
Customer No. 22,852
Attorney Docket No. 09364.8050-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Hochschuler et al.	)	Group Art Unit: 3732
	)	
Application No.: 10/804,955	)	Examiner: Michael B. Priddy
	)	
Filed: March 19, 2004	)	Confirmation No.: 8076
	)	
For: METHOD AND APPARATUS FOR TREATING A VERTEBRAL BODY	)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

FILING PURSUANT TO PATENT
INTERFERENCE NO. 105,252 (KUSLICH v. HOCHSCHULER)

Pursuant to the "Summary of Telephone Conference and Related Orders" (hereafter "Order") dated January 5, 2005, a copy of which is attached, the undersigned is providing the Examiner with the following information. More specifically, the undersigned was ordered to reproduce for the Examiner each of the Counts in the above interference, namely Counts 1-3, provide a copy of the Order and identify the relevant portion of the Order for the Examiner.

Counts 1-3 in this interference are reproduced below, and the Examiner's attention is directed to the second paragraph of page 1 and the first full paragraph of page 2 of the Order. Kuslich alleges in the above interference that Hochschuler claims

1, 6, 19, 32 and 33 of this application correspond to the same patentable invention as at least Count 3 in the interference.

Count 1

The Count is claim 1 of U.S. Patent No. 6,740,093 to Hochschuler et al. or claim 11 of the Kuslich Application No. 10/440,036.

A method of treating an vertebral body comprising the steps of:

creating a cavity in the vertebral body through an access aperture;

inserting a container into said vertebral body;

said container having a fill passage coupled to said container;

deploying said container within said vertebral body;

injecting a bone filler material into said container through said fill passage.

Count 2

The Count is claim 3 of U.S. Patent No. 6,740,093 to Hochschuler et al. or claim 9 of the Kuslich Application No. 10/440,036.

A method of treating a vertebral body having a superior endplate and an inferior endplate, comprising the steps of:

inserting a container into the vertebral body;

deploying said container within said vertebral body;

injecting a bone filler material into said container under pressure;

whereby said pressure supplies a distraction force to move said superior and inferior endplates apart;

ending injection after said endplates have moved apart.

Count 3

The Count is claim 4 of U.S. Patent No. 6,740,093 to Hochschuler et al. or claim 12 of the Kuslich Application No. 10/440,036.

A method of treating a vertebral body comprising the steps of:

inserting a container into an vertebral body;

said container having a fill passage coupled to said container;

said container having a porous outer membrane sufficiently porous to allow filler material under pressure to leave the container after filling the container;

deploying said container within said vertebral body injecting a filler material into said container through said fill passage with bone filler material in a sufficient volume to allow the bone filler material to exit the container and interdigitates with cancellous bone within said vertebral body thereby reinforcing said bone and stabilizing fractures in said bone;

said container membrane porosity sufficient to provide resistance to the flow of said bone filler material to generate force to move the endplates of said vertebral body.

The Examiner is requested to contact the undersigned if he or she has any questions regarding the above matters.

Please charge any required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Date: January 10, 2005

By: _____
Michael R. McGurk
Reg. No. 32,045

Enclosure:
Summary of Telephone Conference and Related Orders

THIS DOCUMENT WAS NOT WRITTEN FOR PUBLICATION AND IS NOT BINDING PRECEDENT OF THE BOARD

Filed by: Judge Jameson Lee
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Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Judge Jameson Lee)

STEPHEN D. KUSLICH, JAMES W. AHERN,
LEON J. GROBLER and STEVEN J. WOLFE

Junior Party

(Application 10/440,036),

v.

STEPHEN HOCHSCHULER, WESLEY JOHNSON,
KEVIN L. NICKELS, THOMAS R. HEKTNER
LARRY WALES and TYLER LIPSCHULTZ

Senior Party

(Patent 6,740,093).

Patent Interference No. 105,252

Summary of Telephone Conference
and Related Orders

On January 4, 2005, a telephone conference was held between the administrative patent judge (APJ) and respective counsel for the parties. The subject matter of discussion was the list of each party's intended motions (Paper Nos. 19 and 20).

With respect to Items 1 and 2 on junior party Kuslich's list, the proposed motions are not authorized. The APJ proposed to have the examiner review the claims in those cases in light of the counts in this interference and if the examiner is of the view that at least some claims in those

cases correspond to one or more counts in this interference, then the examiner should take measures to not issue the case(s) pending the outcome of this interference. Senior party Hochschuler may submit arguments, ex parte, to counter any position taken by the examiner. Counsel for both parties are satisfied with this proposal. In that connection, it is herein

ORDERED that senior party Hochschuler shall file a paper in each of Applications 10/804,955 and 10/804,761, reproducing for the examiner each of the counts in this interference, enclosing for the examiner a copy of this communication, and bringing the examiner's attention to this particular paragraph, and serve a copy of the same on junior party Kuslich, within three business days of the date of this communication.

The motions identified in Items 3 and 4 of junior party's list are authorized.

The priority motions identified in Items 5-9 of junior party's list, including motions alleging derivation of invention, are authorized but deferred. An order setting times for filing those motions will issue in due course.

As for the motion identified in Item 10 of junior party's list, counsel for the junior party explained that the junior party had already obtained a correction of named inventorship, which correction was not reflected on the Notice Declaring Interference. The APJ instructed counsel for the junior party to ascertain and verify, by calling the examiner, the status of any previously filed request to correct inventorship and indicated that if in fact the junior party's request had already been granted, then the problem can be fixed by the APJ's issuing a re-declaration of interference, naming only the properly corrected names. Consequently, the motion according to Item 10 is not authorized.

The motions identified in Items 1-7 of senior party Hochschuler's list are authorized. However, the APJ instructed the parties that motions alleging unpatentability over prior art should rely on the best art and not rely on a multiplicity of separate grounds. The APJ imposed the limitation of subjecting each claim to only one attack under 35 U.S.C. § 102 and also only one

attack under 35 U.S.C. § 103, precluding assertion of alternative grounds of unpatenbtability within each statutory section.

The priority motions identified in Item 8 of senior party Hochschuler's list is authorized but deferred. A order setting times for filing these motions will issue in due course.
As for the motions referred to in Items 9 and 10 of senior party's list, counsel for the senior party explained that he only wanted to give notice that these motions might be filed although at this point he does not yet know whether any valid ground exists for filing them. They are not authorized. However, if and when counsel for senior party learns of a proper basis for filing them, he may initiate a conference call to renew the request and shall be prepared to justify any and all delay in making the renewed request. As for responsive motions identified in Item 11, it is premature to make a request for filing them. It is

ORDERED that each party shall have five business days, after the filing of the other party's substantive non-priority motion, to request authorization for the filing of any responsive motion.

The parties raised for the APJ's consideration whether certain threshold matters can be considered in advance of other motions, in large part because a decision on the threshold issues may well eliminate all other issues. Specifically, the parties proposed that the motions identified in Items 1 and 2 of senior party's list be considered in advance of other motions. The two motions are respective attacks on junior party's claims 9 and 12 as being without written description in the specification under 35 U.S.C. § 112, first paragraph. Junior party's claim 9 is the only junior party claim corresponding to Count II and junior party's claim 12 is the only junior party claim corresponding to Count III. The parties also indicated that an early resolution of junior party's charge of derivation by the senior party may also result in termination of the interference.

The APJ ruled that requesting early resolution of the derivation issue is premature because the parties have not yet worked out just how a decision on that issue will terminate the

interference no matter which way the decision goes. The APJ also indicated that he will not take on an early consideration of both the written description issue as well as the derivation issue ahead of all other motions.

It was recognized that the written description issue is indeed a threshold issue which may terminate the interference insofar as Counts II and III are concerned, if the motion alleging lack of written description has merit. The APJ explained that if the parties can propose a schedule that would allow advance consideration of the motions alleging lack of written description and the attendant responsive motion to add or amend claims, ahead of all other motions, without moving back Time Periods 7 and 8, then the threshold issue of written description can be considered first. To facilitate the schedule in that regard, the APJ indicated that the Board can issue a decision on senior party's two motions alleging unpatentability based on lack of written description for junior party's claims 9 and 12, and on any responsive motion of the junior party in that regard to amend or add claims, within three weeks of the completion of the filing of those motion papers and underlying evidence.

The conference call ended with the parties agreeing to explore possible schedules to propose to the APJ to allow advance consideration of senior party's intended motions alleging lack of written description for junior party's claims 9 and 12. Counsel for the parties both recognize that for all other motions they can stipulate to extensions of Time Periods 1-6 so long as Time Periods 7 and 8 are not changed.

January 5, 2005

Jameson Lee
Administrative Patent Judge

Interference No. 105,252
Kuslich v. Hochschuler

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